

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re U.S. Application of:

Andrew WATSON

) Art Unit: 3691

Application Number: 09/453,800

) Examiner: Stefanos KARAMIS

Filed: 12/03/1999

For: SYSTEMS AND METHODS FOR BUILDING A PERSONALIZED ACCOUNT

SUPPLEMENTAL SUMMARY OF INVENTION TO APPEAL BRIEF

Commissioner for Patents

U.S. Patent and Trademark Office

Customer Service Window, Mail Stop **Appeal Brief - Patents**

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Sir:

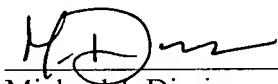
The undersigned thanks the Examiner for allowing this opportunity to bring the Appeal Brief into compliance with 37 CFR §41.37. With regard to the concise explanation of the subject matter under 37 CFR §§ 41.37(c)(1)(v), the undersigned representative submits herewith a supplemental Summary Of Invention. Further, with regard to the concise statement of each ground of rejection to be considered on appeal under 37 CFR §§ 41.37(c)(1)(vi), the undersigned representative submits herewith a supplemental Grounds Of Rejection To Be Reviewed. The amendments to this Appeal Brief are in accordance with the Examiner's suggestions. Accordingly, the undersigned respectfully requests these supplemental sections be considered in review of this Appeal.

Should there be any further issues regarding the Appeal Brief and/or the prosecution of this application in general, please do not hesitate to contact the representative of record.

Respectfully submitted,

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This is an Appeal Brief under 37 C.F.R. § 41.37 in connection with the Final Office Action (“Final OA”) mailed 01/12/2005. Each of the topics required by Rule 41.37 is presented herewith and is labeled appropriately. This Appeal Brief has been amended in response to the Notice of Non-compliance mailed on 05/30/2007, for failure to comply with 37 C.F.R. 41.37(c).

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REAL PARTY IN INTEREST

Universal Card Services Corporation, assignee of the entire right, title, and interest in the present application, is the real party in interest.

RELATED APPEALS AND INTERFERENCES

NONE

STATUS OF CLAIMS

Claims 1 – 21 are pending in the application. Claims 14 – 17 of the present application stand rejected under 35 U.S.C. §102(e) as anticipated U.S. Patent No. 5,970,478 to Walker et al. (“WALKER ‘478”). Claims 1 – 13 and 18 – 21 stand rejected under 35 U.S.C. §103(a) as unpatentable over WALKER ‘478 in view of U.S. Patent No. 6,434,534 (“WALKER ‘534”). The rejection of Claims 14 – 17 is appealed.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

This summary of claimed subject matter is a concise explanation of the subject matter defined in the independent claims. This is merely meant to be a summary and is in no way intended to limit the pending claims.

Independent claim 1 provides a method of offering account based services comprising: providing a baseline offer for a first account based service (p. 13, ll. 3-7; Fig. 3); receiving a first preference indicator signal (p. 14, ll. 3-5; Fig. 3); adjusting the baseline offer so as to form a first modified offer based upon the first preference indicator signal (p. 15, ll. 17-19; Fig. 3); adjusting the first account based service so as to form a second account based service based upon the first preference indicator signal (p. 15, l. 20- p. 16, l. 2; Figs. 3-4); and providing the first modified offer for the second account based service (p. 15, ll. 12-19; Fig. 3); wherein the baseline offer includes at least one benefit from an entity other than the account issuer (p. 13, ll. 11-16; Figs. 7-25).

Independent claim 14 provides a computer system comprising a first computer wherein the first computer comprises: a firewall module for determining security parameters (p. 9, ll. 1-5; Figs. 2-3); an applicant module for collecting data (p. 9, ll. 15-17; Figs. 2-3); a checker module for determining worthiness parameters in real time in conjunction with a credit rating entity external to the computer system (p. 9, ll. 15-19; Figs. 2-3); and an account services building module for receiving preference indicator signals indicative of features associated with an account-based service (p. 10, ll. 5-11; p. 14, ll. 3-5; Figs. 2-3).

Independent claim 18 provides a method of offering account based services comprising: providing a baseline offer for a first account based service, wherein the baseline offer includes at least one benefit from an entity other than the account issuer (p. 13, ll. 3-7; p. 13, ll. 11-16; Fig. 3; Figs. 7-25); providing a list of available features (p. 13, ll. 11-16; Figs. 7-25); receiving a first preference indicator signal associated with a first feature from the available features (p. 13, ll. 11-16; p. 14, ll. 3-5; Fig. 3; Figs. 7-25); adjusting the baseline offer so as to form a first modified offer based upon the first preference indicator signal (p. 15, ll. 17-19; Fig. 3); adjusting the first account based service so as to form a second account based service by combining the first feature onto the first account based service so as to form the second account based service (p. 15, l. 20-p. 16, l. 2; Figs. 3-4); and providing the first modified offer for the second account based service (p. 15, ll. 12-19; Fig. 3).

GROUNDS OF REJECTION TO BE REVIEWED***Rejection of Claims 14 – 17 Under 35 U.S.C. §102***

Claims 14-17 remain rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,970,478 to Walker (WALKER '478). To establish a *prima facie* case of anticipation under 35 U.S.C., several criteria, including the following, must be met. *See* MPEP §2131 (citing statute, case law, and regulation).

- Each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference.

The elements must be arranged as required by the claim.

ARGUMENT

Rejection of Claims 14 – 17 Under 35 U.S.C. §102 as Anticipated by WALKER ‘478

Claims 14 – 17 include the following limitation:

a checker module for determining worthiness parameters in real time in conjunction with a credit rating entity external to the computer system.

The Final OA asserts that WALKER ‘478 discloses this limitation.

Walker ‘478 teaches a computer system with a modem for outside communication to bank agent terminals (Figure 2).
Further Walker ‘478 teaches credit rating stored in a consumer database in which the credit rating may be obtained from such external reporting agencies as TRW or EQUIFAX (column 6, lines 29-47) .

Clearly, WALKER ‘478 does not disclose that the modem is a *checker module* capable of checking *worthiness parameter in real time with a credit rating entity external to the computer system*. While a modem **may** be used as **one** element, e.g., a communications interface component, of such a *checker module*, modems have no inherent structure to act as a *checker module*.

Since, WALKER ‘478 does not disclose each and every element as set forth in the claim, and WALKER ‘478 does not arrange elements as claimed, the Final OA fails to establish a *prima facie* case of anticipation. As such, this rejection of Claims 14 – 17 should be withdrawn.

CLAIMS

I claim:

1. (previously presented) A method of offering account based services comprising:

providing a baseline offer for a first account based service;

receiving a first preference indicator signal;

adjusting the baseline offer so as to form a first modified offer based upon the first preference indicator signal;

adjusting the first account based service so as to form a second account based service based upon the first preference indicator signal; and

providing the first modified offer for the second account based service;

wherein the baseline offer includes at least one benefit from an entity other than the account issuer.

2. (original) The method of claim 1 further comprising:

receiving a second preference indicator signal;

adjusting the first modified offer so as to form a second modified offer based upon the second preference indicator signal;

adjusting the second account based service so as to form a third account based service based upon the second preference indicator signal; and providing the second modified offer for the third account based service.

3. (original) The method of claim 1 further comprising:

providing a list of available preference indicator choices along with providing the baseline offer.

4. (original) The method of claim 1 further comprising:

providing a list of available preference indicator choices along with providing the first modified offer.

5. (original) The method of claim 3 further comprising:

selecting the list of available preference indicator choices from a universe of possible preference indicators.

6. (original) The method of claim 3 further comprising:

receiving personal information; and determining a qualification based on the personal information.

7. (original) The method of claim 6 further comprising:

using the qualification to select the list of available preference indicator choices from the universe of all possible preference indicator choices.

8. (original) The method of claim 6 further comprising:

using the qualification to form the baseline offer.

9. (original) The method of claim 6 further comprising not providing the baseline offer dependent upon the qualification.

10. (original) The method of claim 6 wherein the qualification is a credit line.

11. (original) The method of claim 1 wherein the first and second account based services relate to a credit card account.

12. (original) The method of claim 1 wherein the first and second account based services relate to an insurance account.

13. (original) The method of claim 1 wherein the first and second account based services relate to a telecommunications account.

14. (previously presented) A computer system comprising a first computer wherein the first computer comprises:

a firewall module for determining security parameters;

an applicant module for collecting data;

a checker module for determining worthiness parameters in real time in conjunction with
a credit rating entity external to the computer system; and

an account services building module for receiving preference indicator signals indicative
of features associated with an account-based service.

15. (original) The computer system of claim 14 further comprising a network coupled to
the first computer.

16. (original) The computer system of claim 15 further comprising a second computer
coupled to the network.

17. (original) The computer system of claim 15 wherein the network includes the World
Wide Web.

18. (previously presented) A method of offering account based services comprising:

providing a baseline offer for a first account based service, wherein the baseline offer
includes at least one benefit from an entity other than the account issuer;

providing a list of available features;

receiving a first preference indicator signal associated with a first feature from the
available features;

adjusting the baseline offer so as to form a first modified offer based upon the first preference indicator signal;

adjusting the first account based service so as to form a second account based service by combining the first feature onto the first account based service so as to form the second account based service; and

providing the first modified offer for the second account based service.

19. (original) The method of claim 18 further comprising:

receiving a second preference indicator signal associated with a second feature from the available features ;

adjusting the first modified offer so as to form a second modified offer based upon the second preference indicator signal;

adjusting the second account based service so as to form a third account based service by combining the second feature onto the second account based service so as to form the third account based service; and

providing the second modified offer for the third account based service.

20. (original) The method of claim 18 further comprising:

receiving a second preference indicator signal associated with a second feature from the available features ;

adjusting the first modified offer so as to form a second modified offer based upon the second preference indicator signal;

adjusting the second account based service so as to form a third account based service by deleting the first feature from the second account based service and by combining the second feature onto the second account based service so as to form the third account based service; and

providing the second modified offer for the third account based service.

21. (original) The method of claim 18 wherein the adjusting of the first account based service so as to form a second account based service further comprises:

combining a second feature onto the first account based service so as to form the second account based service.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE

CONCLUSION

With consideration of the above remarks directed to rejections, the undersigned submits that Claims 14 – 17 are in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned, in person or over the telephone, we would welcome the opportunity to do so.

Respectfully submitted,

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